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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,745	09/28/2001	Pat D. Ryan	01CON237P	2982
25700	7590	03/08/2005	EXAMINER	
FARJAMI & FARJAMI LLP 26522 LA ALAMEDA AVENUE, SUITE 360 MISSION VIEJO, CA 92691			TON, DANG T	
			ART UNIT	PAPER NUMBER
			2666	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/965,745	Applicant(s) RYAN ET AL.	
	Examiner DANG T TON	Art Unit 2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/24/02; 1/13/03</u> . | 6) <input type="checkbox"/> Other: _____ |

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-38 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/464,291 in view of Cassing (C6x Solutions for Voice Over IP Gateway) .

For claims 1-38, the claims 1-13 of copending Application No. 10/464,291 disclose a communication method for use by a first gateway device to communicate

with a second gateway device over a packet network, the first gateway device capable of communicating with a communication device over a telephone line, the communication device capable of transmitting V.8bis initiating signals having a first tone segment and a second tone segment, the method comprising the steps of:

- receiving a call request from the second gateway device for the communication device,
- placing a call to the communication device over the telephone Line;
- enabling a tone detector for detecting the first tone segment;

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detecting the first tone segment transmitted from the communication device over the telephone line; and preventing, in response to the detecting step, at least one tone in the first tone segment and the second tone segment from reaching the second gateway device;

wherein the communication device is a modem device;

wherein the preventing step enables a filter to prevent at least one tone in the first tone segment and the second tone segment from reaching the second gateway device;

wherein the first tone segment includes dual tones, and wherein the enabling step enables a single tone detector to detect one of the dual tones;

wherein the first tone segment includes dual tones, and wherein the enabling step enables two tone detectors to detect both of the dual tones;

wherein the step of enabling the tone detector enables the tone detect for a pre-determined period of time;

wherein the first tone segment includes a dual tone, and wherein the filter includes a notch filter centered around one of the dual tones;

wherein the filter includes a plurality of notch filters,

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and wherein each notch filter is centered around a different single tone in the second tone segment; wherein the step of enabling the tone detector enables the tone detector to detect at least one tone in the first tone segment of a initiating signal; further comprising a step of informing the second gateway device of the communication device, in response to the detecting step; further comprising a step of configuring the first modem for MoIP operation; wherein the step of configuring modem for the MoIP operation configures the first gateway device for modem pass through operation; and wherein the step of configuring modem for the MoIP operation configures the first gateway device for modem relay operation.

Note: See claims 1-13 of the copending application number 10/464,291.

For claims 1-38, Applicant's claims 1-38 merely broaden the scope of claims 1-13 of the copending application number 10/464,291 by eliminating the terms " V.bis initiating signals " from the claim 1 of the claims 1-13 of the copending application number 10/464,291. It has been held that the

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omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not need would be obvious to one skilled in the art.

For claims 3,12,27,31,7,15,28,34,37, the claims 1-13 of the copending application number 10/464,291 disclose all the subject matter of the claimed invention with the exception the communication device being a facsimile device and the notch fileter centered around 2100 Hz in a communication network. Cassing from the same or similar fields of endeavor teaches a provision of the Fax modem (see figure 5)and the 2100 HZ (see table 7). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to use the communication device being a facsimile device and the notch fileter centered around 2100 Hz as taught by Cassing in the communications network of the claims 1-13 of the copending application.

The communication device being a facsimile device and the notch fileter centered around 2100 Hz can be implemented/modified into the network of the claims 1-13 of copending application number since the claims 1-13 of the

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copending application number 10/464,29 does teach voice over IP. The motivation for using the communication device being the facsimile device and the notch filter centered around 2100 Hz into the communications network of the claims 1-13 of copending application number being that it provides much higher utilizations while maintaining the guaranteed QoS.

This is a provisional obviousness-type double patenting rejection.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20,26, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Cassing (C6x Solutions for Voice Over IP Gateway) .

Note: the term "capable" is not positively recited claimed limitation . Therefor the limitations after the term are not considered the claimed limitation. It is suggested applicant to remove the work "capable" from the claim.

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For claims 20,26, and 27, Cassing disclose an input (see PCM in figure 5); a filter circuit (see filter in figure 9), an output to provide the second signal for transmission to the second gateway (see PCM Out in figure 5); the communication device being a modem or facsimile device (see FAX modem in figure 5).

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Vargo et al. (6,477,164) and Johnston (6,480,585) are all cited to show systems which are considered pertinent to the claimed invention.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANG T TON whose telephone number is 571-272-3171. The examiner can normally be reached on MON-WED, 5:30 AM-6:00 PM and Thur 5:30-9:30 A.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RAO SEEMA can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Ton



D. TON
PRIMARY EXAMINER